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EXAMINER

PATEL, ASHOKKUMAR B

ART UNIT	PAPER NUMBER
2154	

DATE MAILED: 03/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/098,562

Applicant(s)

KOGUCHI, MASATSUGU

Examiner

Ashok B. Patel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1-13 are presented for examination.

#### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-13 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Claim Objections***

3. Claim 8 is objected to because of the following informalities: Claim 8 indicated "at step (b)." Examiner was not able to find "step (b)" in the claim. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 6, 7, 8, 12 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Toyoda (hereinafter Toyoda) (US 6, 355, 966 B1).

#### **Referring to claim 1,**

Toyoda data transmission apparatus for transmitting image data over a network (Fig. 1, element 11A, Abstract, "An Internet facsimile apparatus makes inquiry about capability, which a destination possesses, to a local server. The server is connected to

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the same LAN as that of the Internet facsimile apparatus. When the local server has no capability information of the destination, the Internet facsimile apparatus makes inquiry to a DNS server and obtains capability information. Then, the Internet facsimile apparatus makes an image to be suitable for the capability of the destination and transmits it to the destination via the Internet.”), the data transmission apparatus comprising:

an image reader for obtaining image data by reading an original document (col. 5, line 20-21, “A scanner 24 scans an original, and obtains image information.”);

a storage device in which the obtained image data obtained is stored (col. 5, line 18-20, “A RAM 23 is a main memory, which executes the program and temporarily stores various kinds of data such as an e-mail, an image file, etc.”);

a requester to request that a recipient to which the image data stored in the storage device is to be sent designates contents of conversion processes to be performed to the image data (Fig. 3, element “Capability Exchange Information”, col. 5, line 42-45, “A capability exchange section 31 has a function of obtaining capability information of a destination terminal by use of a capability exchange operation to be described later.”);

a first receiver to receive recipient's designation of the contents of the conversion processes (Fig. 1, element 13A, Fig. 7, col. 7, line 53-58, “The IFAX 11A makes inquiry about capability information of a desired destination terminal (IFAX 11B) to the server 13A. In this example, capability information of the desired destination

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terminal is not registered in the server 13A. Therefore, the server 13A sends back a response in which no capability information is registered to IFAX 11A.”);

a second receiver to receive the recipient's designation of the contents of the conversion processes via a transmission medium different from that used by the first receiver (Fig. 1, element 14A, Fig. 7, col. 7, line 59-64,” Next, IFAX 11A makes inquiry about capability of the destination terminal to the DNS server 14A, which manages the self-domain name, by use of a name resolver (client software for DNS). The inquiry about capability information is carried out using a command for requesting capability information and a mail address of the destination terminal.”)

a switcher to switch between the first and second receivers depending on the recipient (col. 7, line 53-64,” The IFAX 11A makes inquiry about capability information of a desired destination terminal (IFAX 11B) to the server 13A. In this example, capability information of the desired destination terminal is not registered in the server 13A. Therefore, the server 13A sends back a response in which no capability information is registered to IFAX 11A. Next, IFAX 11A makes inquiry about capability of the destination terminal to the DNS server 14A, which manages the self-domain name, by use of a name resolver (client software for DNS). The inquiry about capability information is carried out using a command for requesting capability information and a mail address of the destination terminal.”

a converter to perform the conversion processes on the image data stored in the storage device based on the contents of the designated conversion processes (Fig. 3, element 20,col. 5, line 45-54,” In the respective processing blocks provided in the data

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processing section 20, CPU 21 control their operation sequence in accordance with the capability of the destination terminal. For example, the compression/decompression section compresses the image signal in a compression format with which the destination terminal can deal. When IFAX 11A has a color function but must send a monochromatic image since the destination terminal has no color function, the color/monochrome section of IFAX 11A can convert a color image to a monochromatic image."); and

a transmitter to transmit, the image data that has undergone the conversion processes to the recipient (Fig. 3, element 33, col. 5, line 66-col. 6, line 2, "Thereafter, the e-mail generated by the e-mail generation section 32 is transmitted to a mail server via the network control section 28 by a mail transmitting section 33.")

**Referring to claim 6,**

Toyoda teaches a data transmission apparatus according to claim 1, further comprising a recipient change receiver to receive an instruction to change the recipient, and wherein the transmitter transmits the image data that has undergone the conversion processes to a new recipient when the recipient is changed. (col. 9, line 6-26)

**Referring to claim 7,**

Toyoda teaches a data transmission method for transmitting image data over a network Fig. 1, element 11A, Abstract), the data transmission method comprising  
obtaining image data by reading an original document (col. 5, line 20-21);  
storing the image data obtained in a storage device (col. 5, line 18-20);

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requesting that a recipient to which the image data stored in the storage device is to be sent designates contents of conversion processes to be performed to the image data (col. 5, line 42-45);

receiving designation of the contents of the conversion processes via one of multiple different transmission media specified depending on the recipient (col. 7, line 53-64);

performing the conversion processes to the image data stored in the storage device based on the contents of the conversion processes designated (col. 5, line 45-54); and

sending to the recipient the image data that has undergone the conversion processes (col. 5, line 66-col. 6, line 2).

**Referring to claim 8,**

Claim 8 is a claim to a data transmission program that causes a computer to execute a process in accordance with the method of claim 8. Therefore claim 8 is rejected for the reasons set forth for claim 7.

**Referring to claim 12,**

Toyoda teaches a data transmission program according to claim 8, wherein the process to be executed by the computer further comprises a step of receiving an instruction to change the recipient, and when the recipient is changed, the image data that has undergone the conversion processes is sent to the new recipient (col. 9, line 6-26).

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**Referring to claim 13,**

Claim 13 is a claim to a recording medium readable by a computer in which the data transmission program recited in claim 8 is stored. Therefore claim 13 is rejected for the reasons set forth for claim 8.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2-5 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toyoda (hereinafter Toyoda) (US 6, 355, 966 B1) in view of Iwazaki (US 6, 687, 742 B1)

**Referring to claim 2,**

Although, Toyoda teaches at col. 5, line 62-64, "The inquiry about capability information is carried out using a command for requesting capability information and a mail address of the destination terminal.", and in Fig. 3, element 33, "mail transmitting section" (a data transmission apparatus according to claim 1, wherein the requester has a mail transmitter to transmit), Toyoda fails to specifically teach an e-mail to request the recipient's designation of the contents of the conversion processes.

Iwazaki teaches "an e-mail to request the recipient's designation of the contents of the conversion processes." (col. 3, line 23-39)



Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention was made to implement the teachings of the Iwazaki on the Toyoda's data transmission apparatus for transmitting image data over a network (Fig. 1, element 11A," An Internet facsimile apparatus makes inquiry about capability") since, as Iwazaki teaches in col. 3, line 13-22," it's invention provides a communication control method for an electronic mail system, which, in a case of transmitting an image in the form of an e-mail to a transmission destination whose capability is unknown, can guarantee interoperability even if the transmission destination is an electronic mail device which has ordinary e-mail software installed therein, and can detect the capability of the transmission destination if the destination has the same function as the sender and can transmit an image according to that capability.", and updates it's own table 36 as well as server 13A.

**Referring to claim 3,**

Toyoda teaches a data transmission apparatus according to claim 2, wherein the first receiver receives the recipient's designation of the contents of the conversion processes based on an instruction sent from the recipient via a setting screen that is used to designate the contents of the conversion processes (col. 6, line 66 through col. 7, line 28). In addition, Toyoda also teaches at col. 18, line 33-35," Moreover, capability information may be registered to the WWW server 17 placed on the Internet, which is easily accessible from the network terminal on the other network. Thus, if a plurality of candidates for inquiry destination exists, it is possible to make inquiry about capability in order of precedence. For example, inquiry may be made in order of the candidate

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having the shortest access time." Toyoda also teaches a technique to receive data through URL at col. 18, line 46-55."( indicates location of data)

Toyoda fails to specifically teach "setting screen referred to by the recipient based on information that was attached to the e-mail and wherein the second receiver receives the recipient's designation of the contents of the conversion processes via an e-mail that was returned from the recipient in response to the e-mail sent by the mail transmitter.

Iwazaki teaches an e-mail to request the recipient's designation of the contents of the conversion processes.(col. 3, line 23-39)(the recipient's designation of the contents of the conversion processes via an e-mail that was returned from the recipient in response to the e-mail sent by the mail transmitter.)

Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention was made to implement the teachings of the Iwazaki on the Toyoda's data transmission apparatus for transmitting image data over a network (Fig. 1, element 11A," An Internet facsimile apparatus makes inquiry about capability") such that the capability information can be received from various sources including URL indicating capability location efficiently. Also, it would have been obvious because as Iwazaki teaches in col. 3, line 13-22," it's invention provides a communication control method for an electronic mail system, which, in a case of transmitting an image in the form of an e-mail to a transmission destination whose capability is unknown, can guarantee interoperability even if the transmission destination is an electronic mail device which has ordinary e-mail software installed therein, and can detect the

capability of the transmission destination if the destination has the same function as the sender and can transmit an image according to that capability.”

**Referring to claim 4,**

Toyoda teaches a data transmission apparatus according to claim 3, wherein the switcher switches to the first receiver when a domain name in an e-mail address of the recipient is identical to a domain name in an e-mail address of a sender (Fig. 5, col. 6, line 43-65), and to the second receiving receiver when the domain name in the e-mail address of the recipient is different from the domain name in the e-mail address of the sender.(Fig. 6, col. 7, line 4-28)

**Referring to claim 5,**

Toyoda teaches a data transmission apparatus according to claim 1, wherein the conversion processes include at least a resolution conversion process, a color conversion process or a file format conversion process.( Fig. 3, element 20,col. 5, line 45-54,” In the respective processing blocks provided in the data processing section 20, CPU 21 control their operation sequence in accordance with the capability of the destination terminal. For example, the compression/decompression section compresses the image signal in a compression format with which the destination terminal can deal. When IFAX 11A has a color function but must send a monochromatic image since the destination terminal has no color function, the color/monochrome section of IFAX 11A can convert a color image to a monochromatic image.”)

**Referring to claim 9,**

Although, Toyoda teaches at col. 5, line 62-64, "The inquiry about capability information is carried out using a command for requesting capability information and a mail address of the destination terminal.", and in Fig. 3, element 33, "mail transmitting section" (the requester has a mail transmitter to transmit), Toyoda fails to specifically teach wherein requesting of the recipient's designation of the contents of the conversion processes is made through transmission of an e-mail.

Iwazaki teaches "requesting of the recipient's designation of the contents of the conversion processes is made through transmission of an e-mail." (col. 3, line 23-39)

Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention was made to implement the teachings of the Iwazaki on the Toyoda's data transmission apparatus for transmitting image data over a network (Fig. 1, element 11A," An Internet facsimile apparatus makes inquiry about capability") since, as Iwazaki teaches in col. 3, line 13-22," it's invention provides a communication control method for an electronic mail system, which, in a case of transmitting an image in the form of an e-mail to a transmission destination whose capability is unknown, can guarantee interoperability even if the transmission destination is an electronic mail device which has ordinary e-mail software installed therein, and can detect the capability of the transmission destination if the destination has the same function as the sender and can transmit an image according to that capability.", and updates it's own table 36 as well as server 13A.

**Referring to claim 10,**

Toyoda teaches a data transmission apparatus according to claim 2, wherein the first receiver receives the recipient's designation of the contents of the conversion processes based on an instruction sent from the recipient via a setting screen that is used to designate the contents of the conversion processes (col. 6, line 66 through col. 7, line 28). In addition, Toyoda also teaches at col. 18, line 33-35," Moreover, capability information may be registered to the WWW server 17 placed on the Internet, which is easily accessible from the network terminal on the other network. Thus, if a plurality of candidates for inquiry destination exists, it is possible to make inquiry about capability in order of precedence. For example, inquiry may be made in order of the candidate having the shortest access time." Toyoda also teaches a technique to receive data through URL at col. 18, line 46-55."( indicates location of data). Toyoda also teaches the request based transmission medium at col. 7, line 53-64.

Toyoda fails to specifically teach "setting screen referred to by the recipient based on information that was attached to the e-mail if the transmission medium is set to the first transmission medium and recipient's designation of the contents of the conversion processes is received via an e-mail returned in response to the e-mail sent if the transmission medium is set to the second transmission medium.

Iwazaki teaches "an e-mail to request the recipient's designation of the contents of the conversion processes." (col. 3, line 23-39)(recipient's designation of the contents of the conversion processes is received via an e-mail returned in response to the e-mail sent)

Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention was made to implement the teachings of the Iwazaki on the Toyoda's data transmission apparatus for transmitting image data over a network (Fig. 1, element 11A," An Internet facsimile apparatus makes inquiry about capability") such that the capability information can be received from various sources including URL indicating capability location efficiently. Also, it would have been obvious because as Iwazaki teaches in col. 3, line 13-22," it's invention provides a communication control method for an electronic mail system, which, in a case of transmitting an image in the form of an e-mail to a transmission destination whose capability is unknown, can guarantee interoperability even if the transmission destination is an electronic mail device which has ordinary e-mail software installed therein, and can detect the capability of the transmission destination if the destination has the same function as the sender and can transmit an image according to that capability.

**Referring to claim 11,**

Toyoda teaches a data transmission program according to claim 10, wherein, at the setting of the transmission medium, the transmission medium is set to the first transmission medium when a domain name in an e-mail address of the recipient is identical to a domain name in an e-mail address of a sender (Fig. 5, col. 6, line 43-65), and the transmission medium is set to the second transmission medium when the domain name in the e-mail address of the recipient is different from the domain name in the e-mail address of the sender (Fig. 6, col. 7, line 4-28).

### ***Conclusion***

**Examiner's note:** Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ashok B. Patel whose telephone number is (571) 272-3972. The examiner can normally be reached on 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John A. Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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Abp

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